PATENT
Attorney Docket No. SYNE-225-E

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Lin et al.	ATTN: Office of Petitions
Application No.: 08/182,183	Group Art Unit: 1647
Filed: May 23, 1994	Examiner: R. Hayes
For: GLIAL CELL LINE-DERIVED NEUROTROPHIC FACTOR	

Commissioner for Patents
Box DAC
Washington, DC 20231

Sir:

PETITION TO REVIVE FOR UNINTENTIONAL ABANDONMENT

The Applicants were formally informed by a Notice of Abandonment received on December 10, 2002 that this application went abandoned for failure to timely file an appeal brief or other paper that put the application in condition for allowance by February 17, 2000. For the reasons described below, the delay in filing an appropriate paper to prevent abandonment was unintentional under 35 U.S.C. § 41(a)(7) and 37 C.F.R. § 1.137(b).

Applicants hereby petition for revival of this application.

1. Petition fee

☐ Small entity - fee $[Fee] (37 CFR 1.17(m))

☒ Other than small entity - fee $1,300.00 (37 CFR 1.17(m))

2. Proposed response and/or fee

A. The proposed response to put this application in condition for allowance, as described below, to the above-noted Office action:

☒ has been filed previously.

☐ is enclosed herewith.

B. The issue fee of $1,300.00

☐ has been filed previously on [Date].

☐ is enclosed herewith.

3. Petition to Revive:

After a final Office Action was mailed in this application on June 15, 1999, applicants acting through their appointed representatives (hereafter "Applicants") made a continuous and diligent effort to put this application in condition for allowance. Unfortunately, these efforts were confounded by a series of misplaced papers in the PTO and a reliance on inappropriate, incorrect, and/or misunderstood oral and written communications from the PTO regarding allowance and reopening of prosecution. Despite repeated assurances from the Examiner that prosecution of this application would be reopened, Applicants were concerned that an issue of abandonment may be raised when a patent ultimately issued. In October 2002, Applicants consulted with outside counsel, Charles E. Van Horn of Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., to seek expert advice on the status of the application and the prosecution strategy, including any required remedial procedures. After several

telephone conferences with the Examiner's supervisor, Gary Kunz, whose cooperation and assistance we gratefully acknowledge, Mr. Kunz and Mr. Van Horn mutually agreed in a telephone conference on November 18, 2002 that this application should be regarded as abandoned. Mr. Kunz indicated that a Notice of Abandonment would be mailed. As mentioned above, the Notice of Abandonment was received by Applicants on December 10, 2002.

4. Proposed Reply

In determining what reply would be required to comply with the provisions of 37 C.F.R. § 1.137(b)(1), Mr. Van Horn again contacted Mr. Kunz by telephone on November 20, 2002, to discuss this matter. Mr. Kunz confirmed that the entry of: (1) the terminal disclaimer filed August 15, 2000, (2) the paper filed July 10, 2002, that addressed certain informalities in the sequence listing, and (3) the paper filed October 17, 2002, canceling claims 88-90, 94, 117-135, 137-140, 142-160 and 165-177 without prejudice, and adding claims 178-210 would place this application in condition for allowance. Accordingly, Applicants request that the three papers identified above be entered and be accepted as an appropriate reply to accompany this petition to revive.

5. Statement Regarding Delay

The file record in this application shows that a final Office Action was mailed June 15, 1999, setting a three-month period for response. A response was timely filed on July 9, 1999, within one month of the Office Action. Upon receiving no Advisory Action, a Notice of Appeal was filed on December 14, 1999.

Applicants placed a status call to Examiner Hayes on January 21, 2000. Examiner Hayes orally indicated that a Notice of Allowance would be sent by January 31, 2000. No such notice was received. Instead, Examiner Hayes later telephoned to request evidence that a Notice of Appeal had in fact been filed. Applicants sent by facsimile to Examiner Hayes on May 11, 2000 copies of the Notice of Appeal and the stamped (December 17, 1999) return receipt postcard. On May 12, 2000, an Advisory Action was mailed indicating the application was not in condition for allowance, certain claims were allowable and the Appeal Brief was due. Upon receipt of the Advisory Action on May 17, 2000, Applicants placed a telephone call to Examiner Hayes who indicated that prosecution would be reopened to address the issues identified in the Advisory Action. On May 18, 2000, less than a week after the Advisory Action was mailed, Applicants sent by facsimile a communication to Examiner Hayes proposing several amendments for discussion and requesting an opportunity to discuss the final issues. No response to this communication was ever received from the Office.

In a telephone conference with the Applicants' representative, Attorney Dan Curry, on August 10, 2000, the Examiner again promised that prosecution of the case would be reopened to address the issues identified in the Advisory Action. On August 15, 2000, Applicants sent by facsimile with a certificate of facsimile transmission a signed amendment in accordance with that proposed on May 18, 2000 and an executed Terminal Disclaimer over U.S. Patent 6,093,802 to address the "last remaining issues identified by the Examiner" (language from Applicants' Status Inquiry filed on March 29,

2001, the file has no record of a double patenting rejection being made by the Examiner). In a later telephone conference, the Examiner requested that the Applicants provide an additional draft amendment with reordered and renumbered claims in order to facilitate completion of the "reopened examination". This new draft amendment was sent by facsimile on October 10, 2000. Again, Applicants received no further communication from the Patent and Trademark Office regarding the application. On March 29, 2001, Applicants sent by first class mail a Status Letter to the Examiner. On July 02, 2001, Attorney Curry made a notation on the file that the case would be reopened and that he would retransmit to the Office the draft of October 10, 2000. On October 16, 2001, Applicants' representative Attorney Ron Levy was contacted by Mr. Kunz, Examiner Hayes' Supervisor, concerning the status of the application. Later t same day Attorney Levy spoke to both Examiner Hayes and his Supervisor, Mr. Kunz about the case and Attorney Levy sent the draft amendment of October 10, 2000 (prepared by Attorney Curry) to the Office by facsimile again, with a request to confirm receipt. No confirmation of receipt was returned.

Applicants' representative, Attorney Robert Sharp, contacted the Examiner on February 12, 2002, and again inquired about the status of the case. Examiner Hayes said Applicants could consider the case as being "in the process of being allowed." However, the Examiner said he would not be able to "get to it until mid-April" because of his workload. Attorney Sharp also requested an Examiner's interview summary but Examiner Hayes refused to issue a summary. Instead, Examiner Hayes promised to

review the last paper filed and allow the case in April. In order to facilitate this review, Attorney Sharp arranged for hand delivery of the following items to Examiner Hayes on March 12, 2002: a hard copy of the Draft Amendment from October 10, 2000, a paper and computer readable copy of the Revised Sequence Listing, five pieces of previous correspondence originally sent between May 18, 2000 and October 16, 2001, and an Associate Power of Attorney for the present case.

On April 30, 2002, Attorney Sharp again called Examiner Hayes and found out that nothing had been done with respect to the case again. Examiner Hayes, however, offered assurances that by May 10, 2002, Applicants would be notified of what would be required to bring the case to a condition for allowance.

After May 10, 2002 passed without any further developments, a phone conference with Examiner Hayes, his supervisor Gary Kunz, and Applicants' attorneys Levy and Sharp was arranged to discuss the situation. During that conference it was decided that a Notice to Comply with Sequence rules was necessary in the present case and that Examiner Hayes would work with Attorney Sharp via facsimile to address any remaining formalities within the claims. On June 10, 2002, the Office mailed a Notice to Comply with Sequence Rules. The June 10, 2002 communication also contained statements purporting "to clarify the record". The communication stated that the copy of the after final amendment that was filed on 8/15/00 but not matched to the case was considered as not being timely filed under 37 C.F.R. 1.8(a) & (b) because "the statutory period for filing a Brief ended 7/14/00." In addition, the June 10, 2002

communication stated that "because new grounds of rejection are now necessitated (i.e., as it relates to an obvious double patenting rejection over U.S. Application No. 08/451374; now U.S. Patent 6,093,802), all previously allowed claims are no longer allowed, and the finality of the Office action mailed 6/15/99 is hereby withdrawn in view of the new grounds of rejection."

On July 10, 2002, Applicants timely filed by Express Mail a reply to the June 10 communication including a Response and Amendments addressing the application's failure to Comply with the Sequence Rules and the Examiner's concerns with respect to the new grounds of rejection.

On August 30, 2002, Attorney Sharp faxed another Draft Amendment to Examiner Hayes in another attempt to place the application in condition for allowance. After calling the Examiner to discuss the draft amendment, Applicants learned that he had not received the draft amendment. Accordingly, another draft copy was sent by facsimile on October 16, 2002. Additionally, a signed copy of the amendment was sent by facsimile with a certificate of facsimile transmission to the Office on October 17, 2002. As noted above, around this time Attorney Sharp contacted one of Amgen's outside counsel, Mr. Van Horn, with respect to the prosecution of this application. A copy of Amgen's application file for Application No. 08/182,183 was sent to Mr. Van Horn on October 17, 2002. Mr. Van Horn was out of the country on business between October 20 through November 7 and again from November 24-30. Mr. Van Horn spoke with Mr. Kunz on November 12 and 18 about the status of the present application a

whether it was appropriate to withdraw the finality of the Office Action. Mr. Van Horn and Mr. Kunz agreed that despite the statements made by the Examiner to the contrary this application should be regarded as abandoned. Mr. Kunz agreed to have a Notice of Abandonment issued by the Office. The Notice of Abandonment was received by Applicants on December 10, 2002. On November 20, 2002, Mr. Kunz was contacted to determine whether the replies already filed in this application would place the application in condition for allowance. After consulting with the Examiner, Mr. Kunz agreed that such replies would place the application in condition for allowance. Thus, Applicants understand that no further reply is required with this petition to revive.

Accordingly, Applicants have continuously and diligently taken all reasonable steps to move this application toward allowance. For all the reasons noted above, the entire delay in filing the required reply from the due date until the filing of this grantable petition under 37 C.F.R. § 1.137(b) was unintentional.

NOTE: APPLICANTS ARE NOT CERTAIN AS TO WHETHER THE OFFICE HAD THE AUTHORITY TO WITHDRAW THE FINALITY OF THE 6/15/99 OFFICE ACTION UNDER THE CIRCUMSTANCES OF THE PRESENT CASE. THIS PETITION IS TO BE CONSIDERED MOOT IF THE PTO DID HAVE AUTHORITY TO WITHDRAW THE FINALITY OF THE 6/15/99 ACTION UNDER THE PRESENT CIRCUMSTANCES. FURTHERMORE, IT IS BELIEVED THAT THE OFFICE WAS INCORRECT IN INDICATING THAT "THE STATUTORY PERIOD FOR FILING A BRIEF ENDED 7/14/00". RATHER, IN THE ABSENCE OF ANY EXTENSIONS OF TIME (NONE

WERE PAID), THE PERIOD TO FILE AN APPEAL BRIEF EXTENDED ONLY TO FEBRUARY 17, 2000 - 2 MONTHS AFTER THE NOTICE OF APPEAL WAS RECEIVED IN THE OFFICE - NOT JULY 14, 2000, AS WAS STATED IN THE COMMUNICATION MAILED JUNE 10, 2002.

6. Terminal Disclaimer

This application was filed before June 8, 1995. A Terminal Disclaimer under 37 C.F.R. § 1.137(b)(4) would normally require the disclaimer of a period of 1069 days (equivalent to the delay between the date of abandonment [February 18, 2000] and the filing of a grantable petition [January 22, 2003]). However, a terminal disclaimer has already been filed in this application that would disclaim any term beyond July 25, 2017, the full term of U.S. Patent No. 6,093,802. It should be understood that the terminal disclaimer filed with this petition to revive operates from the full statutory term of 17 years from the date of patent grant to which a patent issuing on a patent application filed May 23, 1994, would be entitled, and not from the term as shortened by any terminal disclaimer associated with the '802 patent.

7. Conclusion

Applicants respectfully assert that this petition should be granted and the application file promptly returned to the Examiner for mailing a Notice of Allowance and Issue Fee Due.

If there are any other fees due in connection with the filing of this response, including any fees required for an extension of time under 37 CFR § 1.136, such an

extension is requested, and the Commissioner is authorized to charge any related fees to our Deposit Account No. 01-0519.

Please continue to address all correspondence to:

U.S. Patent Operations/RLS
Dept. 4300 M/S 27-4-A
AMGEN INC.
One Amgen Center Drive
Thousand Oaks, California 91320-1799

Respectfully submitted,

AMGEN INC.

By: Robert L Sharp
Robert L. Sharp
Reg. No. 45,609
(805) 447-5992

Dated: January 21, 2003

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: 21 January 2003

By: Charles E. Van Horn
Charles E. Van Horn
Reg. No. 40,266
(202) 408-4072

Attachments

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Lin et al.	Group Art Unit: 1647
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Commissioner for Patents
Washington, DC 20231

Sir:

TERMINAL DISCLAIMER
PETITION TO REVIVE UNDER 37 C.F.R. § 1.137(b)

Assignee, Amgen Inc., duly organized under the laws of Delaware and having its principal place of business at One Amgen Center Drive, Thousand Oaks, CA 91320, represents that it is the assignee of the entire right, title and interest in and to the above-identified application, Application No. 08/182,183, filed May 23, 1994 for GLIAL CELL LINE-DERIVED NEUROTROPHIC FACTOR in the names of Leu-Fen H. Lin, Franklin D. Collins, Daniel H. Doherty, Jack Lile, and Susan Bektesh to Synergen, Inc., as indicated by assignment duly recorded in the United States Patent and Trademark Office at Reel 7107, Frame 0214 and as further indicated by assignment from Synergen, Inc. to Amgen Inc. as duly recorded in the United States Patent and Trademark Office at Reel 8371, Frame 0136 on February 24, 1997.

Assignee hereby disclaims the terminal 1069 days of any patent granted on the above-identified application or on any application, entitled to a 17-year from grant patent term, that contains a specific reference under 35 U.S.C. §§ 120, 121 or 365(c) to this application. This disclaimer operates from the full statutory term of 17 years from the date of patent grant to which a patent issuing on a patent application filed May 23, 1994, would be entitled, and not from the term as already shortened by the terminal disclaimer associated with U.S. Patent No. 6,093,802. This disclaimer is binding upon the grantor, its successors or assigns.

In accordance with the fee schedule set forth in 37 C.F.R. § 1.20(d), the required fee of $110.00 is being filed with this disclaimer.

If a check for the required fee is not filed concurrently herewith or if there are any additional fees due in connection with the filing of this Terminal Disclaimer, please charge the fees to our Deposit Account No. 01-0519. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to Deposit Account No. 01-0519.

The undersigned is authorized to act on behalf of assignee Amgen Inc.

Respectfully submitted,

By: Robert L Sharp
Signature

Name: Robert L. Sharp
Title: Attorney
Registration No: 45,609
Assignee: Amgen Inc.

Dated: January 21, 2003

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